

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being filed with Dianne Maggard of the United States Patent and Trademark Office by facsimile transmission on October 20, 2005 to facsimile telephone number (571) 273-0300.



Peter G. Seferian

40,162

(Reg. No.)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant(s):	Walke <i>et al.</i>	Group Art Unit: 1652
Application No.:	09/783,320	Appeal No.: 2005-2440
Filed:	February 15, 2001	Examiner: D.M. Ramirez
Title: Novel Human Kinases and Polynucleotides Encoding the Same		Atty. Docket No. LEX-0137-USA

**RESPONSE TO ORDER UNDER 37 C.F.R. § 41.50(d)**  
**DATED SEPTEMBER 22, 2005; AND WITHDRAWAL OF APPEAL**

Mail Stop Appcal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellants acknowledge the receipt of the Order under 37 C.F.R. § 41.50(d) ("the Order") in the above-referenced case, mailed on September 22, 2005, which has been carefully reviewed and studied. Appellants herein respond as ordered.

**RESPONSE**

As stated in the Order, "we require Appellants to explain why we should again address the same line of argument in this case; since the same arguments were considered and thoroughly addressed in Appeal No. 2004-1732, why would the previous panel's treatment of those arguments not be dispositive here?" (Order at page 4 lines 16-19).

Appellants note that while Appeal No. 2004-1732 and the present Appeal do share some issues, several of the arguments in the present Appeal are unique. Appellants further note (with some confusion as to why the Order was a necessity in the first place), that while the Board's position in the Order is that essentially the same arguments have been previously considered, clearly they appear to recognize that the present Appeal Brief contained additional unique arguments. This is evidenced by what would appear to be footnote 3, in which the Board attempts to discount there differentiating facts and arguments (the Order at the bottom of page 4). Although the Board has briefly addressed these new arguments in "footnote 3", Appellants respectfully question whether a footnote in an Order Under 37 C.F.R. § 41.50(d) is the proper forum for the disposition of new arguments not previously considered by the Board. As set forth by the U.S. Court of Appeals for the Federal Circuit ("the Federal Circuit") in *Gechter v. Davidson* (43 USPQ2d 1030, (Fed. Cir., 1997)), "the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review" (emphasis added). To the best of Appellants' knowledge, only a final Decision on Appeal from the Board is appealable to the Federal Circuit, not an Order Under 37 C.F.R. § 41.50(d), presently leaving Appellants no forum to argue the Board's disposition of the new arguments set forth in the Appeal Brief in the present case, as detailed in "footnote 3".

Thus, *inter alia*, the matters that differentiate the present Appeal from that of Appeal No. 2004-1732 are that, in addition to referring to unique sequences, the instant Appeal Brief describes evidence that those of skill in the art would readily recognize the instant molecules as encoding the human kinase known as NEK-1 and that kinase proteins were a class of proteins with a very well-established, substantial and specific utility with a well defined and well-established function (phosphorylation) at the time this application was filed.

#### **WITHDRAWAL OF APPEAL**

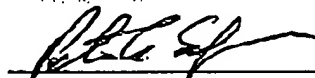
While Appellants do not agree with the rejections set forth by the Examiner in the present case, and do not agree with the Board that "The Appeal Brief in this appeal includes essentially the same arguments that were made and rejected by the previous merits panel in Appeal No. 2004-1732" (the Order at page 3), Appellants hereby withdraw the present appeal (Appeal No. 2005-2440) without prejudice and without disclaimer in order to pursue claims in a continuing application.

A one month non-extendable time limit for response is set forth in the Order. The response is therefore timely filed, and Appellants believe no fees are due in connection with this response. However, the Commissioner is authorized to charge any required fees or credit any overpayment to Deposit Account No. 50-0892.

Respectfully submitted,

October 20, 2005

Date



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# Fax

**To:** Dianne Maggard  
Board of Patent Appeals and Interferences

**From:** Peter G. Seferian

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**Fax:** 571-273-0300

**Date:** October 20, 2005

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**Phone:**

**Pages:** 4 (including coversheet)

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**Re:** Appeal No. 2005-2440  
Application Serial Number: 09/783,320  
Atty. Dkt. No. LEX-0137-USA

**CC:** File

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**•Comments:**

Please find attached a Response to the Order Under 37 C.F.R. § 41.50(d) in reference to the above-referenced appeal. Please contact me at the number shown above if there are any questions.